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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/568,277

11/09/2006

Takuya Kodama

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EXAMINER

YOON, TAE H

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

12/01/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/568,277	Applicant(s) KODAMA ET AL.	
	Examiner Tae H. Yoon	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 10 and 11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 10 and 11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 01229064 A in view of JP 2001139768.

English abstract of JP'064 teaches novolac phenol resin having a Mn of 500-700 and Mw of 1000-1500 with less than 3% of unreacted phenols. Table 2 on page 3 of JP document shows Mn 550 and Mw 1100, Mn 600 and Mw 1200, and Mn 600 and Mw 1320 which would meet the instant polydispersity (Mw/Mn). JP'064 further teaches employing a mixture of various fibers including wollastonite and glass fibers, and example show employing total 75 vol.% of fillers. Again, the recited use of a phosphoric acid and a mol ratio of a phenol and an aldehyde in a reaction has no probative value in the instant product claims. Applicant's asserted high yield in said reaction is not a claimed limitation. An invention in a product-by-process is a product, not a process. See *In re Brown*, 459 F2d 531, 173 USPQ 685 (CCPA 1972) and *In re Thorpe*, 777 F2d 695, 697, 227 USPQ 964 (Fed. Cir. 1985). Also, the intended use has no probative value.

The instant invention further recites amounts of said wollastonite and glass fibers over JP'064. However, use of a higher amount of fillers in novolac compositions in order to improve mechanical properties is well known practice as taught by English abstract of JP'768 discussed in the previous office action.

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It would have been obvious to one skilled in the art at the time of invention to utilize instant amounts of a mixture of wollastonite fiber and glass fiber in JP'064 with teaching of JP'768 since JP'064 teaches employing a mixture of various fibers including wollastonite and glass fibers and since use of a mixture of wollastonite and glass fiber in the instant amounts is also well known as taught by JP'768 absent showing otherwise.

Claims 1-4, 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2001139768 in view of JP 01229064 A.

JP'768 teaches molding composition comprising 15-75 wt.% of novolac phenol resin, 35-65 wt.% of wollastonite and 5-35 wt.% of glass fiber and a molded article thereof in abstract. Amount of wollastonite is about 47% (75/35) to 433% (65/15) of said novolac. Amount of glass fiber is about 7% (5/75) to 233% (35/15) of said novolac. Thus, amounts of fillers taught by JP'768 encompass the instant amounts. Abstract teaches that unreacted phenol was removed, and thus it would meet the instant amount of monomeric and dimeric phenols. The recited use of a phosphoric acid in a reaction has no probative value in the instant product claims. Also, the intended use has no probative value. The wollastonite is inherently fiber, if not, it is well known by JP'064.

The instant invention further recites Mw and polydispersity (Mw/Mn) of said novolac phenol resin over JP'768. The teaching of Mw of 50000 or less encompasses the instant Mw of 3700 or less, and novolac resin with the instant Mw and polydispersity (Mw/Mn) is well known as taught by JP'064

It would have been obvious to one skilled in the art at the time of invention to utilize novolac resin with the instant Mw and polydispersity of JP.064 in JP'768 with wollastonite and glass fibers in the instant amounts since amounts of fillers are overlapped and since choosing a range within a range is a *prima facie* obviousness since novolac phenol resin having the instant Mw and polydispersity is well known in the art and since the teaching of Mw of 50000 or less in JP'768 encompasses the instant Mw absent showing otherwise.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H. Yoon whose telephone number is (571) 272-1128. The examiner can normally be reached on Mon-Thu.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Tae H Yoon/
Primary Examiner
Art Unit 1796

THY/November 24, 2008